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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 3718611-01530	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____		Application Number 10/660,077	Filed September 10, 2003
		First Named Inventor Anthony J. Baerlocher	
		Art Unit 3714	Examiner Andrew Kim
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>35,602</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>2</u> forms are submitted.</p>			

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Anthony J. Baerlocher, et al.
Appl. No.: 10/660,077
Conf. No.: 5899
Filed: September 10, 2003
Title: GAMING DEVICE HAVING BONUS GAME DEPENDENT UPON
VARIABLE WAGER COMPONENT SELECTION
Art Unit: 3714
Examiner: Andrew Kim
Docket No.: 3718611-01530

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

This request is submitted in response to the Office Action of March 29, 2010 ("Office Action") and filed with form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal." Applicant believes the Examiner's interpretation of the prior art in the Office Action rises to the level of clear error, making the case proper for pre-appeal review. Please charge Deposit Account No. 02-1818 the Notice of Appeal fee set forth under 37 C.F.R. §41.20(b)(1) and any other fees due. Claims 1 to 25 are pending in this application. Claims 26 to 35 stand cancelled.

In the Office Action, the Examiner rejected independent Claims 1, 16, and 21 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,186,894 ("Mayeroff") in view of U.S. Publication No. 2003/0069056 ("Cormack").

Mayeroff discloses a gaming device having a primary game and a bonus game. After a player makes a wager on at least one payline in the primary game, the gaming device spins the reels. The gaming device provides the player with any awards associated with winning symbol combinations indicated on any wagered-on paylines. If a designated symbol combination occurs, the gaming device determines a number of bonus spins to provide to the player based on the number of wagered-on paylines in the primary game or the number of credits wagered on each payline. The gaming device provides the player with the determined number of bonus spins for the bonus game.

Cormack discloses a gaming device wherein, upon an occurrence of a trigger condition in a primary game, the gaming device awards a number of free spins to a player. The gaming device displays the total number of free spins that have been accumulated by the player during a gaming session. The gaming device enables the player to choose when to use any of the accumulated free spins.

In the Office Action, the Examiner equates the "change of the meter" of Claim 1 to the awarding of bonus spins to the player in Mayeroff. The Examiner reasons that, in Mayeroff, the "change of the meter" is of an amount which is determined based on the selected different second component of the wager for the play of the base game because the number of bonus spins awarded to the player is based on the number of wagered-on paylines in the primary game or the number of credits wagered on each payline in the primary game. Based on this reasoning, the Examiner argues that Mayeroff substantially discloses the invention of Claim 1. However, the Examiner admits that Mayeroff fails to disclose that the number of bonus plays earned from the play of the base game is displayed in a bonus game. The Examiner states that Cormack teaches a meter which displays how many free games are available to the player. The Examiner concludes that it would have been obvious to modify Mayeroff to include displaying a number of available free games to enable the player to know how many free games are available and to select when to use the free games.

Regardless of whether it would have been obvious to modify Mayeroff in the manner proposed by the Examiner, the resulting gaming device would not render obvious the gaming device of Claim 1. More particularly, Mayeroff and Cormack do not render obvious a memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to operate with the at least one display device and the at least one input device to, if the player selects at least a threshold amount for the first component of the wager for the play of the base game and the displayed outcome for the play of the base game includes a designated outcome, trigger a bonus game associated with a meter displayed in the bonus game, the meter being changeable each time the bonus game is triggered, wherein, each time a change of the meter occurs during the bonus game, the change is of an amount which is determined based on the selected different second component of

the wager for the play of the base game and not based on the total wager value of the wager placed and any outcome which occurs in the play of the base game.

The "change in the meter" of Claim 1 has two key characteristics. First, the change of the meter occurs during the bonus game. Second, the change of the meter is of an amount which is determined based on the selected different second component of the wager for the play of the base game and not based on the total wager value of the wager placed and any outcome which occurs in the play of the base game.

The Examiner's basis for the obviousness rejection of Claim 1 completely overlooks the first characteristic. While Mayeroff discloses awarding a number of free spins to the player based on the number of wagered-on paylines in the primary game or the number of credits wagered on each payline in the primary game (i.e., interpreted by the Examiner to be the "change of the meter"), this change does not occur during the bonus game. As described above, in Mayeroff, when the designated symbol combination occurs in the primary game, a number of bonus spins are awarded to the player. The number of bonus spins awarded to the player (i.e., the interpreted amount by which the meter changes) is based on a wager component (e.g., the amount wagered per payline or the number of wagered-on paylines). After the bonus spins are provided to the player, the player can then use the bonus spins to play the bonus game. Thus, in Mayeroff, the awarding of bonus spins (and, therefore, the change in the meter based on the wager component) occurs before the bonus game and not during the bonus game.

In Mayeroff, once the player begins to use the bonus spins for the bonus game, each time a bonus spin is used or executed by the player, the number of bonus spins remaining (i.e., the meter) changes or decrements by one. As the player uses or plays each of the provided bonus spins during the bonus game, the number of bonus spins remaining continues to change or decrement by one to track how many bonus spins are left. For example, if a player wagers on nine paylines in the primary game and obtains a designated symbol combination, the gaming device provides nine bonus spins to the player (Col. 7, lines 35 to 38). In this example, the meter in Mayeroff would initially include nine bonus spins. After the player uses a first one of the bonus spins, the meter decrements by one. After the player uses a second one of the bonus spins in the bonus

game, the meter decrements by one again, and so on. Therefore, in Mayeroff, the only change in the meter which occurs during the bonus game is when the meter decrements as the bonus spins are played. This change in the meter is constant (i.e., using one bonus spin causes the meter to decrement by one) and is not associated with or based on a wager component. Accordingly, Mayeroff does not disclose a meter displayed in the bonus game, the meter being changeable each time the bonus game is triggered, wherein, each time a change of the meter occurs during the bonus game, the change is of an amount which is determined based on the selected different second component of the wager for the play of the base game and not based on the total wager value of the wager placed and any outcome which occurs in the play of the base game.

Cormack does not cure the deficiencies in Mayeroff. As described above, Cormack displays how many free spins are available to the player at any given point during the gaming session. Similar to Mayeroff, as the player uses each of the available free spins in Cormack, the displayed number of free spins decrements by one. Thus, the Cormack meter changes (i.e., decrements) during the bonus game in a constant manner and not based on a wager component. Accordingly, the gaming device resulting from the combination of Mayeroff and Cormack does not render obvious each and every element of independent Claim 1.

For at least these reasons, the rejections of independent Claim 1 and the claims depending therefrom are clearly erroneous and should be overturned. For similar reasons, the rejections of independent Claims 16 and 21 (and the claims depending therefrom) are also clearly erroneous and should be overturned.

The Examiner's reasoning for rejecting certain of the dependent claims is equally flawed. For example, with respect to the rejection of Claim 15 over Mayeroff, in view of Cormack, in further view of U.S. Pat. No. 6,155,925 to Giobbi, the Examiner states that:

Mayeroff in view of Cormack et al. substantially discloses the invention as claimed but fails to explicitly [disclose] a second bonus game played if the player does not select at least the threshold amount for the first component of the wager in the base game and achieves the designated outcome in the base game. However, in an analogous gaming device reference, Giobbi et al discloses multiple bonus games played in accordance with varying wagering thresholds.

The Examiner concludes that:


it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Mayeroff to include multiple bonus game for varying wager amounts, as disclosed by Giobbi et al.

On page 3 of the Office Action, regarding the rejection of Claim 1, the Examiner states that Mayeroff requires the player to place a threshold wager of at least one payline to play the primary game and have the opportunity to trigger the bonus game. In other words, the Examiner acknowledges that for the player to be eligible for the bonus game in Mayeroff, the player must place a minimum wager (i.e., activate one of the paylines) to play the primary game. Later in the Office Action, in the rejection of Claim 15, the Examiner argues that it would have been obvious to modify Mayeroff with Giobbi to include a different bonus game if the player does not place the threshold wager. This statement contradicts the Examiner's previous statements regarding Mayeroff's threshold wager. Under the Examiner's own interpretation of Mayeroff, if the player places less than the threshold wager (i.e., if the player does not wager on one of the paylines), the player would not be able to play the primary game and, as a result, would not have the chance to play the bonus game. As described above and as acknowledged by the Examiner, Mayeroff requires the player to place a minimum wager to activate one payline (i.e., a threshold wager) to be eligible for the bonus game.

The Examiner cannot first state that Mayeroff requires a wager of a threshold amount for the player to be eligible for the bonus game and then rely on Giobbi for providing a different bonus game if the player's wager is less than the threshold amount.

Accordingly, at least with respect to the rejection of Claim 15, the Examiner's reasoning is fundamentally flawed and should be overturned.

Respectfully submitted,
K&L Gates LLP

BY 
Adam H. Masia
Reg. No. 35,602
Customer No.: 29159

Dated: June 24, 2010